

Second, the request seems particularly inappropriate given the late stage of the present prosecution. This case is now pending for more than 5 years. The prior Examiner apparently had little difficulty searching the relevant prior art, and evaluating the claims for more than 3 years based on the materials presented in the record. There is no evidence or argument to date to suggest that this field of art is any more difficult to search, or that there is a lack of available information for the Examiner to review.

Again, several office actions and responses have been exchanged, and in fact agreement was reached by the prior Examiner in a lengthy telephonic interview more than 18 months ago on the scope of allowable subject matter. According to the PTO's own Director of Office of Patent Legal Administration, Mr. Robert J. Spar:

“...A rule 1.105 requirement presents a substantial burden on applicant..
Make a requirement only where the need is compelling.
Specifically articulate the scope and attributes of the requirement...
No fishing expeditions are allowed.

...
If used, should generally accompany a first action rejection on the merits...”

See, e.g. Patent Business Goals - Final Rule, IPO - PTO Day Conference, December 11, 2000.¹

Thus, with all due respect, it seems extremely late and unsupportable for the PTO (there have been no less than six separate Office Actions²) to be suggesting that there is now a “compelling need” for such items when prosecution has been ongoing for some time without the same, and absent any indication that the Applicant somehow has particular unique knowledge that is somehow required by the PTO.

Moreover by waiting for so many years to make such request, Applicants are subjected to even more burden by the fact that they are handicapped in attempting to garner and reconstruct the specific information requested. For these reasons Applicant traverses the present request as well as any future such requirement.

¹ Available at: www.ipo.org/Template.cfm?Section=Home&Template=/ContentManagement/ContentDisplay.cfm&ContentID=12666

² See Office Actions of 11/08/02; 5/20/03; 8/5/03 (Advisory Action); 11/10/03; 6/2/04; and 3/28/05 all discussing the substance of the present claims.

Finally, as to the following information requested on pages 2 – 3:

“...for each publication, please provide a concise explanation of the reliance placed on that publication in the development of the subject matter.”

While such latitude is suggested in the MPEP, Applicant is unable to discern where such request is permitted within the limited scope of the express language of 37 C.F.R. 1.105, and thus traverses such request as well.

DETAILED RESPONSE:

The following information is presented to respond to each category of information requested by the Examiner. As noted above, while Applicant has been prejudiced by this late request, he has nonetheless attempted in good faith and after reasonable diligence to compile the information below. Nothing in the submission below should be taken as an admission that: (a) such information is material or even relevant to the present claims; (b) that no other information exists which could be responsive to the Examiner’s request. This information is presented solely for compliance with 1.105, and no other rule or regulation.

Response to item #1:

In category #1, the Examiner requests

“....a copy of any non-patent literature, published application, or patent (U.S. or foreign) by any of the inventors, or information that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result....”

- As to materials “by” the inventor: there are none.
- As to the other materials requested: the request seems vague to the Applicant, since it is unclear what is meant by “used” in the invention process. Nonetheless Applicant provides the following list of items which were known to Applicant prior to the filing of the present application.

Patents:

6041308	6021398	6012046
6012045	5924082	5835896
5845266	5689652	5897620

Websites:

Please note that there can be no guarantee that the content of such sites is identical or even substantially the same as it was on or about April 28, 2000, when Applicant filed the instant disclosure:

EZLinksGolf	TheGolfer.com	TeeTrade.com
Tickets.com	Bid4Vacation.com	Greens.com
Book4Golf.com	LinksTime.com	OpenTable.com
FoodLine.com	Tickets.com	MovieTickets.com
Broadway.com	eReserve (www.erreserve.com)	
Xtime (www.xtime.com)		

Applicant makes no representation and cannot readily confirm that any of such items were ever "used" in developing the present invention, or that "reliance" was placed on any of such publications in the development of the instant subject matter. The above list is merely provided to ensure as comprehensive a response as possible given the Examiner's request and to give the Examiner the full benefit of Applicant's review and compilation. To the extent any such items above were considered even tangentially relevant from a patentability perspective, they have already been disclosed in the present disclosure and/or in one or more IDS provided already to the PTO.

Moreover, to the extent such items were ever reviewed, Applicant believes at this time - from reviewing such materials - that such review was merely for purposes of confirming that they in fact did not teach the inventions embodied in the present claims. In particular, based on Applicant's best recollection at this time, Applicant believes that the websites listed above were reviewed to identify offerings, functionality, limitations, etc. at some time prior to the filing of the present application.

The golf-related web sites including EZLinksGolf, TheGolfer.com, TeeTrade.com, Greens.com, Book4Golf.com, and LinksTime.com were reviewed to explore the potential use of auctions in golf tee time reservations and most were found not to offer auction services. A few were found to offer tee time auction services utilizing a standard highest bid auction method but none were found that offered an auction method for mutually exclusive items such as that described in the present invention.

The non-golf related web sites including Tickets.com, Bid4Vacation.com, OpenTable.com, Tickets.com, MovieTickets.com, Broadway.com and xTime.com were reviewed to explore the use of

auctions for mutually exclusive items such as dinner reservations, vacations and movie/show tickets. Auctions were generally not used by these web sites and none used an auction method for mutually exclusive items such as that described in the present invention.

Response to item #2:

- Working prototype: neither the inventor nor anyone working on his behalf has created a working of the claimed invention; Applicant is unaware if others have created such prototypes; nonetheless a mock up of a preferred embodiment of a web site was developed and screen shots of that mock up appear in the original patent filing;
- Commercial availability: neither the inventor nor anyone working on his behalf has commercialized the invention. Applicant has not conducted a formal infringement analysis to determine if there are third parties commercializing products/services which incorporate the claimed subject matter.

Response to item #3:

See above; Applicant is unaware of trade names/providers of products or services in competition with the present invention.

Response to item #4:

The present invention is not assigned formally to any entity.

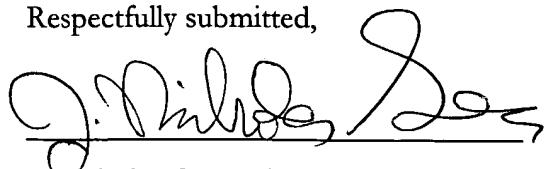
CONCLUSION

Applicant has complied fully with the Examiner's request for additional information. In some instances, as noted above, such information is provided despite the fact that it does not appear required under 37 C.F.R. 1.105. The information provided above does not alter the reasons for patentability already articulated and of record in the present proceedings.

A petition and fee for an extension of time is enclosed as well. Please charge any fees due to deposit account no. 501-244.

Should the Examiner wish to discuss the present case in person, he is invited to please contact the undersigned at any convenient opportunity.

Respectfully submitted,



J. Nicholas Gross, Attorney
Registration No. 34,175
Attorney for Applicant(s)

2030 Addison Street
Suite 610
Berkeley, CA 94704
510 - 540 - 6300
510 - 540 - 6315

I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this 10th day of November 2005.